Rejection under 35 U.S.C. § 102 over the Rink Reference

Claims 1-21 were rejected as anticipated by the Rink et al. reference, U.S. Patent 5,759,631. Applicants respectfully traverse the rejection and request reconsideration.

As a matter of law, the Rink patent does not anticipate the present invention.

To anticipate an invention, a reference "must sufficiently describe the claimed invention to have placed the public in possession of it." *Minnesota Mining and Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 24 U.S.P.Q.2d 1321 (Fed. Cir. 1992) [hereinafter *3M*]. In *3M*, for example, a claim to an orthopedic casting fabric having particular thickness and mesh size parameters was not anticipated by disclosure in a prior reference of an orthopedic casting fabric that was a knit fiberglass. *Id.* at 1332. Even though the claimed parameters were "subsumed in [the prior reference's] generalized disclosure of knit fiberglass as a substrate," the prior reference "provide[d] no guidance as to how to construct a fiberglass cast with the beneficial properties achieved by the [claimed] invention." *Id.* While the prior reference's fiberglass *could* have the claimed thickness and mesh size parameters, from which the beneficial properties would necessarily flow, the prior reference was not "exact enough to identify" what the parameters were that would produce such beneficial properties. *Id.*

In the same way, the Rink reference does not sufficiently describe the present invention to place the public in possession of it. The Rink reference uses very broad ranges for its parameters that include ranges that are unsuitable for achieving the benefits of the present invention. Furthermore, the Rink reference does not disclose that certain parts of its ranges of certain specific parameters must be combined to

achieve the benefits of the present invention. The present invention concerns refinish compositions including an hydroxyl functional acrylic polymer with a number average molecular weight of at least about 5000 and that has been polymerized using at least about 45% by monomer weight of a cycloaliphatic monomer. Even though these parameters may be "subsumed" in the Rink patent's "generalized disclosure" of hydroxyl-functional acrylic polymers, there is no guidance whatever on how to formulate a refinish coating to obtain the beneficial properties of the present invention. The Rink patent makes no reference to benefits of choosing acrylic polymers prepared with at least 45% cycloaliphatic monomer and selecting number average molecular weights of 5000 or more. Not only do the preferred ranges of Rink lead one away from making such a combination, but the Rink patent also provides not one concrete example of a composition meeting either one of these requirements of the present invention separately, let alone both together.

The examples in the accompanying Declarations of Emerson Keith Colyer and Ali Rihan demonstrate that the fast-drying characteristics of the presently claimed refinish compositions are not available from random selection of compositions within the generalized disclosure of the Rink reference. Even when the declarants selected the Rink example with the level of cycloaliphatic monomer closest to the presently claimed invention, and increased it number average molecular weight to the upper limit of the preferred Rink range, the dry times for the Rink coating compositions were markedly longer than those of the present invention.

It is the law, as illustrated by the *3M* case, that there is no anticipation when the reference teaches nothing more than broad ranges that may subsume the limitations of the invention.

Similarly, the Federal Circuit held in *Ultradent Products Inc. v. Life-Like Cosmetics, Inc.*, 44 U.S.P.Q.2d 1336 (Fed. Cir. 1997) that a prior reference's disclosure of materials that might, with serendipity, be selected to fall within the claimed invention did not amount to an anticipating disclosure. The claim involved a material for bleaching teeth that had a matrix material having "sufficiently high viscosity" and being "sufficiently sticky" to have certain properties. *Id.* at 1341. The defendant asserted that the claims were invalid as anticipated by a prior reference because increasing the percent of a material, carboxypolymethylene, in one of the patent examples produced the required properties. *Id.* The court ruled that even if the adjusted example provided the claimed viscosity and stickiness, "that does not mean that the claimed matrix material is necessarily described by the [prior] patent. [T]here are many possible compositions that could be made within the range of carboxypolymethylene concentration (0.05% to 5%) that the [prior] patent discloses." *Id.* at 3141-42. To be anticipating, the prior patent must "describe to one of skill in the art the tested combinations, or other combinations meeting the limitations of the claims, from among the many possible candidates." *Id.* at 1342.

Thus, an anticipating reference must enable one of ordinary skill in the art to select those embodiments that provide the particular advantage of the claimed invention when that advantage is not always available in practicing the prior reference's process. The Rink patent does not anticipate the present invention because it is not "at

once specific and enabling with regard to the particular subject matter at issue." *In re Wilder*, 166 U.S.P.Q. 545, 548 (C.C.P.A. 1970).

Further, Applicants' process is not obvious from the Rink reference, because the Rink reference merely discloses a broad range of choices and provides no guidance on how one might change the refinish coating composition to reduce dry times. For these reasons, the Barker reference neither anticipates nor renders obvious Applicants' invention.

In view of the deficiencies of the Rink reference, Applicants submit that the present claims are patentable. Reconsideration of the claims is, therefore, respectfully requested.

Rejection under 35 U.S.C. § 102(b) over the Rockrath Reference

Claims 1-21 were rejected as anticipated by the Rockrath et al. reference, U.S. Patent 5,716,678. Applicants respectfully traverse the rejection and request reconsideration.

"An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the filed of the invention." *Crown Operations International Ltd. v. Solutia Inc.*, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). The Rockrath patent fails to anticipate claims 1-21 because it does not disclose a refinish clearcoat composition, does not disclose a refinish clearcoat composition containing an acrylic polymer having a number average molecular weight

of at least about 5000, and does not disclose a refinish clearcoat composition containing an acrylic polymer polymerized using at least about 45% by weight of a cycloaliphatic monomer, based on the total weight of monomers polymerized.

First, the present invention is directed to a "refinish clearcoat composition." The Rockrath reference does not teach, disclose, or suggest any refinish composition. Applicants discuss the attributes of refinish coating compositions at length. See, e.g., paragraphs 0003 and 0004. Automotive refinish coating compositions are recognized as a distinct coatings technology. See, e.g., Coatings, Encyclopedia of Polymer Science and Engineering, Supplemental volume, pages 118-19 (H.F. Mark ed. 1989). One key attribute and requirement of a refinish coating is the ability to cure at room temperature or a very low temperature of room temperature or up to about 150°F (65°C.). See paragraph 3 and 4. In contrast to a refinish coating composition, the compositions of the Rockrath patent are production line (also called OEM) coatings cured at 130-140°C. Col. 7, lines 24-29; col. 9, lines 46-49. The Rockrath patent nowhere describes or suggests a refinish coating composition, nor does the Examiner contend that it does. Because it does not describe a refinish coating composition, however, it cannot anticipate the present claims. The passage in column 9 to which the Office Action refers does not describe a refinish process, but rather describes application of the original topcoat finish over the primer layers, with a bake carried out for 20 minutes at 140°C (284°F). Such a temperature would be impossible for a refinish because the many plastic components of the vehicle would be damaged and because body shops do not have the equipment for carrying out such a bake.

Thirdly, the Rockrath patent does not disclose a refinish basecoat containing an acrylic polymer. As already discussed, the Rockrath patent's disclosures concerning basecoat compositions are very limited. At most, the Rockrath patent discloses that basecoat compositions can contain water or organic solvents (col. 1, lines 60-61) and aluminum pigment (col. 9, lines 43-44). No basecoat composition binders are mentioned, let alone acrylic polymers. Because the Rockrath patent does not describe a refinish basecoat containing an acrylic polymer, it cannot anticipate the present claims.

Further, the Rockrath patent does not disclose a refinish basecoat containing an acrylic polymer having a number average molecular weight of at least about 6000 or an acrylic polymer polymerized with at least about 45% by weight of a cycloaliphatic monomer, based on the total weight of monomers polymerized. While the patent mentions number average molecular weights of "from 1500 to 10,000, preferably from 2500 to 5000" and describes polymerizing 28-85% by weight of a methacrylate ester selected from the group of aliphatic and cycloaliphatic methacrylates, it lacks the teaching of an acrylic having a number average molecular weight of at least about 6000 and "at least about 45% by weight of a cycloaliphatic monomer" that is necessary to anticipate the present invention. *See Minnesota Mining and Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 24 U.S.P.Q.2d 1321 (Fed. Cir. 1992), discussed above.

The general disclosures of the Rockrath reference do not enable one to practice the invention and obtain the advantages of the invention. "Before a reference can be found to disclose a feature by virtue of its inherency, one of ordinary skill in the art viewing the reference must understand that the unmentioned feature at issue is necessarily present in the reference." *SGS-Thomson Mircroelectronics, Inc. v. International Rectifier Corp.*, 32 U.S.P.Q.2d 1496, 1503 (Fed. Cir. 1994) (citing *Continental Can Co. USA Inc. v. Monsanto Co.* 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991)). To be "necessarily present" the feature must *always* be present in what the prior reference describes. *W.L. Gore & Associates v. Garlock, Inc.*, 220 U.S.P.Q. 303, 314 (Fed. Cir. 1983) (no anticipation where the claimed product had a "unique nature" and the processes of the prior references would not always inherently "produce products meeting all of the claim limitations"). The skilled artisan, armed with all that the Rockrath patent discloses, would have no direction for obtaining the benefits of Applicants' invention.

Thus, an anticipating reference must lead one of ordinary skill in the art to select those embodiments that provide the particular advantage of the claimed invention when that advantage is not always available in the prior reference's compositions. In the present case, the Rockrath patent provides no guidance to the skilled artisan who wishes to reduce the dry time of a refinish clearcoat composition because the Rockrath patent does not suggest any kind of *difference in results* between the compositions that contain aliphatic methacrylates and those that contain cycloaliphatic methacrylates, between the compositions that contain at least about 45% by weight of cycloaliphatic monomer and those that do not, and between compositions containing an acrylic

polymer having a number average molecular weight of at least 5000 and those that do not.

Furthermore, there is no specific example disclosed in the Rockrath patent that falls within the present claims. The only example with a cycloaliphatic monomer, "Polyacrylate resin solution (2)" in column 8, contains 23.9% by weight cycloaliphatic monomer. (Its number average molecular weight is not provided.)

Because the Rockrath reference does not teach or disclose all of the important aspects of the claimed invention, and does not fairly suggest any of these aspects, the present invention is patentable over the Rockrath reference. Applicants, therefore, respectfully request withdrawal of the rejection and reconsideration of the claims.

For all of these reasons, Applicants respectfully assert that the claims are patentable over the Rockrath patent. Accordingly, Applicants request withdrawal of the rejection and reconsideration of the claims.

Rejections for Obviousness-Type Double Patenting

Claims 1-21 have been rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-23 of copending Application No. 09/850,837 and unspecified claims of copending Application No. 09/886,742. Applicants respectfully traverse this rejection and request reconsideration.

The Office Action states that the present claims are not patentably distinct because "they both claim clear coating composition." That is not correct, however, because, while the present claims are directed to clear coating compositions, the claims

of Application No. 09/850,837 and Application No. 09/886,742 are directed to basecoat coating compositions. The Examiner has provided no reasoning that would support a conclusion that the clearcoat composition claimed would have been obvious from the claims alone of the cited applications. This is particularly so when clearcoat coatings and basecoat coatings are different types of coatings that must be formulated to meet different requirements.

Accordingly, Applicants submit that a prima facie case of obviousness has not been made out and request that the rejections be withdrawn.

Conclusion

Applicants believe that the claims are in condition for allowance, and an early allowance of the application is earnestly requested.

The Examiner is invited to telephone if it would be helpful to resolving any matter.

Respectfully submitted,

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